REMARKS

Applicant has carefully reviewed the final Office Action dated May 18, 2006. In response, reconsideration of the outstanding rejections is respectfully requested in light of the following remarks.

Initially, applicant respectfully submits that no basis whatsoever exists for making the most recent Office Action final. As acknowledged by the examiner, applicant's amendments did not necessitate any new ground of rejection. Instead, applicant attacked the examiner's *prima facie* case of unpatentability, since the rejections failed to follow the proper procedures by identifying in the prior art all claim limitations. The examiner for the first time in the final Office Action cites additional factual support and presents previously unaddressed arguments in an effort to make the rejections allegedly proper. However, nothing in the rules or MPEP requires making an Office Action final when a *prima facie* rejection is lacking, and then allegedly made for the first time in a subsequent Office Action. Quite the contrary, the MPEP at Section 706.07 specifically cautions the examiner to "never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal," given that due process concerns are at play. Since applicant has not had a "full and fair hearing" with respect to the newly cited support for the rejections made, the examiner should withdraw the finality of the Office Action and give the applicant an opportunity to respond formally to the new basis for the rejections and set a proper record for purposes of appealing the rejections.

As presented in the last Amendment document, independent claim 1 explicitly recites an average fiber diameter for the various fibers recited

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of "18-22 microns." Similarly, independent claim 27 as previously presented explicitly recites an average fiber diameter of between "18-30 microns." Both of these claims also expressly require a material with 20-60% by weight of a low melt bicomponent fiber.

The examiner continues to rely solely on U.S. Patent No. 5,851,355 to Goettmann alone in support of the rejections of claims 1 and 27 on obviousness grounds. However, several significant points of distinction between the claims and the Goettmann arrangement continue to be ignored in making these rejections. For instance, with regard to the "20-60% by weight" low melt bicomponent fiber limitation, the examiner now fully admits that Goettmann "teaches outside Applicant's claimed range . . . ." Nevertheless, the examiner still finds that it would have been obvious to provide between 2 and 6 times as much low melt bicomponent fiber as taught in Goettmann.

Despite the examiner's maintenance of this position, the record still lacks any **substantial, objective evidence** as to why it would be obvious to modify the Goettmann structure as claimed. The statement is made that "Goettmann provides support to adjust various parameters such as the amount of bicomponent fibers." However, the mere fact that the prior art structure can be adjusted (which is always the case) does not alone establish that it would be obvious to "optimize the amount of low melt bicomponent fibers" as contended, when there is otherwise no cited motivation or suggestion to do so.

Furthermore, the examiner without citing any objective evidence whatsoever now contends that at least doubling the percentage of low melt bicomponent fibers in the manner proposed by the applicant "does not imply a change in porosity only a change in composition of the web." This

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statement flies in the face of the express teachings of Goettmann that porosity is crucial to the invention disclosed therein (see, e.g., col. 2, lines 66-67, "An important feature of a membrane support substrate is sheet porosity . . ."), and that achieving the desired porosity of 5-10 cfm necessary for a reverse osmosis filter involves using 1-10% by weight of low melt bicomponent fibers. Using the examiner's logic, a composite material comprised of 99% low melt bicomponent fibers and 1% binder fibers would necessarily have the same porosity as the material having 1% of the low melt bicomponent fibers and 99% of binder fibers. This wayward conclusion is supported nowhere in the record, and in fact is contraindicated by Goettmann itself! (see, e.g., col. 3, lines 36-38, "as the quantity of polyester increases . . . , . . . porosity increases."). Since the examiner's argument is mere speculation, the statement made in the Office Action regarding applicant's argument not qualifying as evidence is equally applicable. Reconsideration is therefore respectfully requested.

A second distinction between the claimed inventions and the arrangement described in the Goettmann patent arises with regard to the express requirement for an average fiber diameter of between 18-22 microns. In response to applicant's arguments regarding how the maximum value possibly taught by Goettmann for the staple fibers forming but one of the three types of fibers used does not even meet this limitation of the claims, the examiner continues to rely on a value roughly calculated by the applicant "to demonstrate how close the polyester staple fiber diameter [in Goettmann] is to the claimed average fiber diameter." In support of the rejection, the examiner further continues to cite *In re Boesch* for the proposition that the maximum fiber diameter ostensibly taught in

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Goettmann "can be optimized to 18-22 microns," when in fact this patent is completely silent as to the same.

Regardless of the alleged "closeness" of the alleged value discerned from Goettmann to the claimed range for the average fiber diameter, continued reliance on the decision in *Boesch* is unjustified, given that its holding is expressly limited to the concept of optimizing a value ***within*** a range. Since the examiner fully admits that "Goettmann teaches outside Applicant's claimed range," the holding in *Boesch* simply does not support the rejection, and citation to it as authoritative is misplaced. Absent *Boesch,* no authority in the record stands for the proposition advanced by the examiner that a single value being "close" to a claimed range of an average value necessarily establishes obviousness. Therefore, applicant submits that a *prima facie* case of obviousness remains lacking, and that the rejections are subject to reversal on appeal.

In the final Action, the examiner for the first time also cites to evidence supporting the position that "it is known in the art that Kuraray EP-101 fibers and N-720H fibers . . . comprise polyethylene terephthalate as the polyester component." This evidence includes U.S. Patent No. 6,977,111 to Yamaguchi et al., which allegedly describes both types of fibers. However, the examiner's efforts still in no way establish that the fibers disclosed in Goettmann meet the claimed range in terms of average diameter, which is the entire reason this reference is cited. Accordingly, citation to Yamaguchi et al. does not supply the missing teachings necessary to render the claimed inventions obvious.

As for the reference to EP-101 fibers in the '111 Yamaguchi patent, it is completely silent as to whether these are bicomponent fibers at all. Indeed, the evidence cited by the applicant in the last response tends to

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suggest that the EP-101 fibers are not bi-component fibers. The examiner cites to Table 2 of Yamaguchi et al. as allegedly showing that "the non-stretched EP-101 fibers are PET," but this table actually does not expressly mention EP-101 fibers, let alone bi-component fibers having the claimed structure. Since nothing in Yamaguchi et al. establishes that EP-101 fibers are even bi-component fibers, it is entirely unreasonable for the examiner to conclude that these apparently single component fibers are "concentric sheath/core CoPET/PET" as is contended.

After reconsidering these distinctions, it is believed the examiner will agree that the invention as set forth in independent claims 1 and 27 patentably distinguishes over the Goettmann patent and the other references of record. Further, claims 5-7 and 9—14, 16-17, and 19-26 depending from claim 1 and claims 15, 18, and 28 depending from claim 27 patentably distinguish for the same reasons. Accordingly, all the claims remaining in the application are in condition for allowance, and reconsideration of the decision to reject these claims finally is respectfully requested. Any fees required in connection with this Response may be debited to Deposit Account 50-0568.

Respectfully submitted,

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